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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALLEN BERGER, Jr.

Appeal 2008-3564
Application 10/669,900
Technology Center 3600

Decided: July 23, 2008

Before JAMESON LEE, RICHARD TORCZON, and
MICHAEL P. TIERNEY, *Administrative Patent Judges*.

Filed by TORCZON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Claims 1 and 4 stand rejected under 35 U.S.C. § 102(b) as anticipated by prior art (Ans. at 3). The appellant, Allen Berger, Jr. (Berger), seeks review under 35 U.S.C. § 134. We have jurisdiction under 35 U.S.C. § 6(b).

The examiner relies upon the following prior art in rejecting the claims (Ans. at 3):

Hubbard US Patent 5,950,398 14 Sep. 1999

We AFFIRM the rejection.

THE CLAIMED INVENTION

The claims on appeal relate to a surface mounted window for garage doors (Spec. at 1). Berger does not offer separate arguments for claims 1 and 4 (Br. at 5-8). Claims stand or fall together if they are not argued separately. 37 C.F.R. § 41.37(c)(1)(vii). We select claim 1 as broadly representative of the claims on appeal and reproduce it from the appeal brief claims appendix below (Br. at 9) (emphasis added):

A window assembly for garage doors, comprising:

A) a transparent panel having an external surface and an internal surface, said external surface including a coplanarly extending peripheral flange member making said external surface larger than said internal surface with respective external and internal peripheral edges, and said peripheral flange member further including a peripheral underside surface that comes in abutting contact against the peripheral external surface adjacent to an opening in a garage panel with cooperative dimensions to permit said *internal surface to pass through said opening*; and

B) means for mounting said transparent panel on said garage panel.

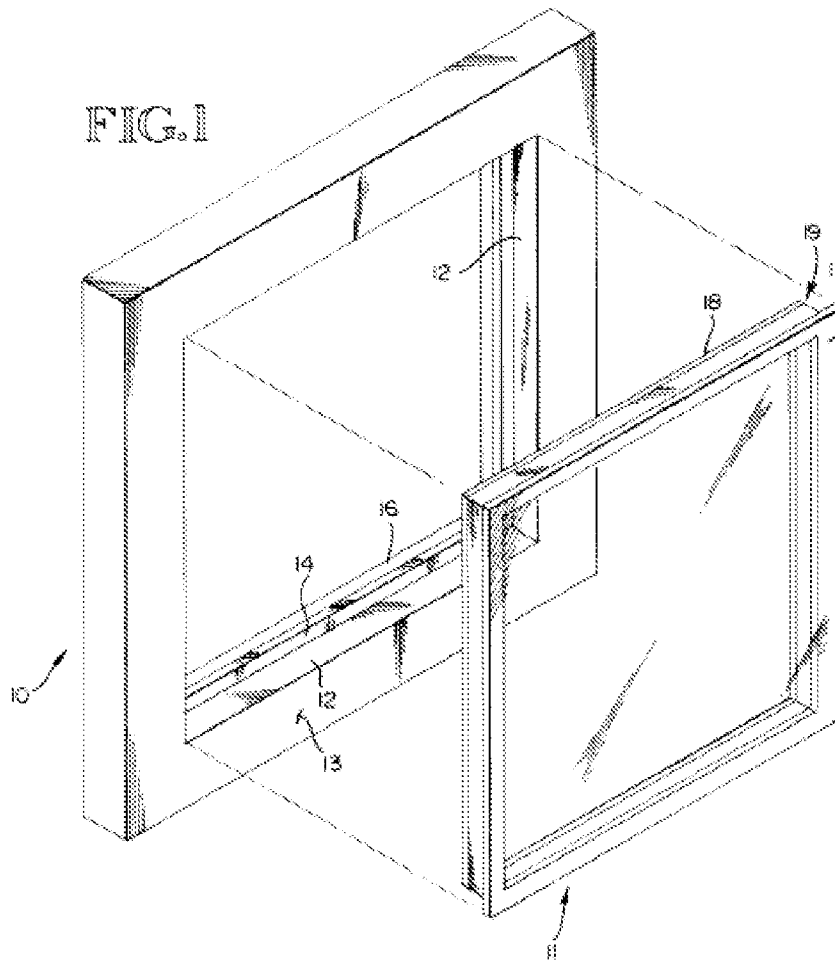
Berger contends that Hubbard does not disclose the limitation emphasized above (Br. at 6). Berger and the examiner have a different interpretation of the claim limitation "opening". Berger also contends that Hubbard uses two panes, while the claimed invention uses one pane (Br. at 7).

ISSUE

Did Berger establish that the examiner erred in rejecting the claims as anticipated by the cited prior art?

FINDINGS OF FACT

1. Hubbard discloses a multiple glazed window unit **11** for replacing single glazing in window openings (Hubbard, col. 1, ll. 7-10 and Hubbard FIG. 1 below, which depicts a partially exploded view of a replacement window unit).



2. Hubbard discloses that the interior pane **18** will be dimensioned so as to pass by the opening in the sash **10** easily and extend over the reveal **16** (Hubbard, col. 3, ll. 64-67).

3. Hubbard defines that the terminology pass-by insulating glass window as the structural configuration of the body of the window unit **11** that enables the interior portion of the unit to pass through the sash opening (Hubbard, col. 3, l. 67 to col. 4, l. 3).

4. Hubbard discloses that the exact configuration and dimensions of the sash **10** will vary widely (Hubbard, col. 2, l. 65 to col. 3, l. 2).

5. Hubbard discloses that the window replacement unit **11** is sized so that the unit passes through the opening provided in the sash **10** and the larger exterior pane **17** is then secured by glazing compound (Hubbard, col. 2, ll. 34-39).

6. Hubbard discloses a replacement window unit **11** where the interior pane **18** is sized so as to pass through the sash opening and over the reveal **16** (Hubbard, col. 2, ll. 21-23).

7. Hubbard discloses that outer pane **17** is larger in dimensions than interior pane **18** (Hubbard, col. 3, ll. 57-62).

8. We find that Hubbard anticipates the invention of claim 1.

PRINCIPLES OF LAW

We must construe pending claims as broadly as their terms reasonably allow. *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). When the examiner rejects the claim, an applicant seeking a narrower construction must either show why the examiner's broader construction is unreasonable or amend the claim to state expressly the scope intended. *In re Morris*, 127 F.3d 1048,

1057 (Fed. Cir. 1997). We focus on the construction of the disputed limitation. *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1580 (Fed. Cir. 1991).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

ANALYSIS

Our analysis starts with claim construction. Berger and the examiner have different interpretations of "opening" in claim 1. We give the contested limitation its broadest reasonable interpretation in view of the specification. Berger has not directed us to a specific definition of "opening" in the specification. In the Appeal Brief, Berger urges that "opening" is the outer surface of Hubbard's sash **13** (Br. at 6). According to the examiner, the claimed "opening" is met by the perimeter of Hubbard's reveal **16** (Ans. at 4). Berger has the burden of showing that the examiner's interpretation of the "opening" is unreasonable. We construe "opening" to include the edges of the reveal **16** where the body of the garage door is not present. Berger has not met its burden of showing that the examiner's interpretation of opening is unreasonable.

Berger argues the inner pane **18** of Hubbard does not pass through the opening of the sash **13** but rather the pane **18** is kept within the sash **13** (Br. at 6). The persuasiveness of Berger's argument depends on the meaning of "opening." Berger's definition of "opening" is not persuasive for reasons already discussed above. We note that the claim does not have "opening of

the sash" as a limitation. We find that Hubbard's replacement window unit **11** passes by the opening in the sash **10** (Finding 2). Hubbard defines the term pass by to mean that the structural configuration of the body of the window unit **11** will enable the interior portion of it to pass through the sash opening (Finding 3). Hubbard teaches that the replacement window unit **11** is sized to pass through the opening in the sash **10** (Findings 4-6). We find that Hubbard discloses the claimed interior surface passing through the opening **16** claimed in Berger (Findings 1-6). Berger has not shown reversible error.

Next, Berger argues that Hubbard does not disclose the claimed "peripheral underside surface that comes in abutting contact against the peripheral external surface adjacent to an opening" (Br. at 6). The examiner found that Hubbard's external surface **17** comes in abutting contact against the peripheral external surface adjacent to the opening **16** (Ans. at 4). According to Berger, Hubbard's external surface **17** is within the opening (Br. at 6). The persuasiveness of Berger's argument again depends on the location of the opening in the garage door as discussed above. We find that Hubbard's replacement window unit is dimensioned so that the exterior pane **17** is larger than the interior pane **18** (Findings 6-7). The peripheral underside surface comes in abutting contact against the rabbet **14**, which is a peripheral external surface adjacent to the opening **16** (Finding 1). Berger has not shown reversible error.

Finally, Berger argues that Hubbard uses two panes **17** and **18**, while their claimed invention uses one pane (Br. at 7). We start our analysis with claim construction. We note the limitation "pane" is not in claim 1. Berger uses the limitation "a transparent panel" in claim 1 (Br. at 9). We must give

the limitation its broadest reasonable interpretation in view of the specification. Berger has not directed us to a specific definition of "a transparent panel" in the specification (Br. at 7).

Berger's argument that the prior art uses two panes while the claimed invention uses one pane is similar to arguments made by the applicant in *In re Morris*, 127 F.3d 1048, 1055 (Fed. Cir. 1997). *Morris*'s claimed invention was an improved acoustic isolation apparatus. In *Morris*, the applicant argued that the claim limitation "integrally formed" should be read as one-piece construction. The examiner cited prior art that disclosed an acoustic isolation apparatus having a two-piece construction. The two pieces were coupled together in the prior art. The two-piece construction in *Morris* is similar to the two pane construction in Hubbard. The court interpreted the meaning of "integral" broadly to encompass multi-piece structures. Integral does not mean one-piece construction absent an express definition in the specification. The court stated that the applicant has the burden of precise claim drafting.

The examiner uses the Hubbard reference, which uses a multi-glazed window unit (Finding 1). According to the examiner, Hubbard discloses a transparent panel **11** having exterior surface **17** and internal surface **18** (Ans. 6). Berger has not met its burden of showing that the examiner's interpretation of "a transparent panel" is unreasonable. We construe the meaning of "a transparent panel" to mean that the panel must be transparent, not that it must be a single pane. We can not construe the meaning of "a transparent panel" more narrowly than Berger elected to write it. Claim 1 does not exclude multiple transparent panels absent an express definition in the specification. Berger failed to precisely define the limitation of "a

transparent panel" in the specification. Berger could have amended the claim to read "single pane" during prosecution. We conclude that the examiner's interpretation of a transparent panel is reasonable. We find that Hubbard teaches the contested limitation (Finding 1). Berger has not shown reversible error (Finding 8).

CONCLUSION

Berger has failed to show that the examiner erred in rejecting the claims over the Hubbard patent. Consequently, the rejection of claims 1 and 4 under 35 U.S.C. § 102(b) is—

AFFIRMED

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